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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,392	08/20/2004	Peter J Dronzek JR.	181-037	7246

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/505,392

Applicant(s)

DRONZEK ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-53 is/are pending in the application.
- 4a) Of the above claim(s) 12-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 11/15/2006 have been entered. Since the amendments and remarks filed on 10/30/2006 are further amended on 11/15/2006, only the latter communication is being considered in present Office action. Claims 1, 4-6 and 8 have been amended. Claim 7 has been cancelled. Claims 1-6 and 8-11 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In view of the amendments to claims 4-6, the rejections under 35 USC 112 are withdrawn.

Double Patenting

4. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/505383. Although the conflicting claims are not identical, they are not patentably distinct from each other because they obviously read on each other as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicants' request at Remarks page 12 to hold this provisional rejection in abeyance is acknowledged. However, there is no provision in the rules for such and therefore the rejection will not be held in abeyance. Appropriate response is required in next reply to the Office action to avoid abandonment of the application.

Rejections Based on Prior Art

5. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 6328340) in view of Hoffman (US 4879430).

Fischer's invention relates to a form having a detachable card. Fig. 1 shows a form sheet 1 of paper and a piece of a substrate material 2. The substrate 2 further comprises a substrate layer 21, a peeling adhesive layer 22, an outer layer 23, and a permanent pressure-sensitive adhesive layer 24. The substrate material is glued to the back of the form by means of the permanent pressure-sensitive adhesive layer 24. The two outer layers 23 and 41 are transparent plastic films, in particular polyester films [col. 4, lines 46-57]. A punching (die cut) runs all the way through the layers 41, 42, 1, 24, 23 and 22 and reaching down as far as the substrate layer 21 [col. 4, line 62 through col. 5, line 5]. During detaching of the card 3, the peeling adhesive 22 is completely detached from the substrate layer 21 and stays with the card. The peeling adhesive layer 22 has a non-permanent adhesive effect with respect to the substrate material 21 and a permanent adhesive effect with respect to the material of the outer layer 23 [col. 5, lines 12-16]. The different adhesive effects with respect to the substrate layer on the one hand (non-permanent) and the outer layer on the other hand (permanent) can in this case be achieved by a suitable process control and/or different pretreatment of the film surfaces on both sides, such as by plasma, corona or flame treatment [col. 3, lines 28-36].

For claims 1, 2, 5, 8 and 11, Fischer lacks a teaching about the percentage of treated area. However, it is noted that Hoffman's invention is directed to a patterned adherent film structure. Hoffman teaches that a web of plastic wherein one surface layer thereof has been subjected to selective pattern of corona discharge treatment such that the face of one surface of the web has a

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pattern therein. This pattern is characterized by selective corona discharge treatment in some areas. Preferably, the pattern has relatively small repeating units [col. 2, lines 35-41]. Further, the configurations associated with a treatment pattern can be used to enhance the increased bond strengths achieved [col. 3, lines 32-34]. Since Fischer teaches that the different adhesive effect with respect to the substrate layer on the one hand (non-permanent) and the outer layer on the other hand (permanent) can in this case be achieved by suitable process control and/or different pretreatment of the film surfaces on both sides, such as by corona treatment, etc., it would have been obvious to one of ordinary skill in the art to modify Fischer's surface treatment method with the a pattern taught by Hoffman, motivated by the desire to obtain an improved controlled amount of differential adhesive effect at interfaces. Regarding the percentage of treated area, since the combined teachings of Fischer and Hoffman render the instant invention obvious, and having the same steps of use [in particular, detaching at the same interface], and the utility as such dictates there would be similar level of surface treatment, a suitable percentage of treated surface area is reasonably considered to be an obvious routine optimization to one skilled in the art of detachable cards.

For claims 3, 4 and 6, Fischer is silent about the thickness of polyester film layer and the weight basis of the paper stock, and difference in surface tension after treatment. However, since Fischer teaches the same subject matter for the same use (detachable card intermediate) as the instant invention, suitable aforementioned limitations are reasonably considered to be obvious routine optimization to one skilled in the art of detachable card intermediate, motivated to obtain required card physical properties and detachability.

For claims 9 and 10, Hoffman shows in Fig. 4 a treatment pattern of a polygon as claimed.

Response to Argument

6. Applicants argue at Remarks page 13 that when the Fischer method is followed, the peelable adhesive is transferred to the card as the card is removed, and disadvantageously causing the removed card to stick to other cards, whereas a pattern of selective variable adhesion covering from 10 to 90 percent of the surface on substrate layer of the instant invention provides a detachable card which is removably adhered, without the need of using a peelable adhesive because the adhesive properties of the surface have been modified. However, applicants' argument that Fischer's method peelable adhesive is transferred to the card apparently contradicts the function of a "peelable" adhesive, and applicants fail to provide any support that a peelable adhesive would necessarily be transferred to the card and cause the abovementioned disadvantage. Applicants' analysis in a vacuum ignore that one of ordinary skill in the art of detachable card intermediate would have obviously selected an adhesive with a suitable peelability to meet the detachable function taught by Fischer. Furthermore, applicants also overlook the teachings of the secondary reference of Hoffman, which teaches a web of plastic wherein one surface layer thereof has been subjected to selective pattern of corona discharge treatment such that the face of one surface of the web has a pattern therein. This pattern is characterized by selective corona discharge treatment in some areas. Since the combined teachings of Fischer and Hoffman render the instant invention obvious, and provide the same use steps, in particular detaching at the same interface, and the utility as such dictates there would be

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similar level of surface treatment, a suitable percentage of treated surface area is reasonably considered to be an obvious routine optimization to one skilled in the art of detachable cards.

Applicants argue at pages 13-14 that the selective adhesion imparted by the pattern of the present invention is achieved by creating a surface where certain areas have no treatment as well as other areas which are treated, whereas Fischer requires all of the surface must be completely treated. However, applicants are arguing against the teachings of Fischer individually, and are respectfully reminded that the basis of rejection are the combined teachings of Fischer in view of Hoffman, which render the instant invention obvious, in particular the adhesive pattern taught by Hoffman inherently provides that certain areas have no treatment as well as other areas which are treated.

Similarly, applicants argue at page 14 that the Fischer reference does not disclose the basic concept of forming a higher and lower adhesion that is formed on a surface under a die cut removable card formed on a business form, as provided by the adhesive pattern in the amended claims. However, the combined teaching of Fischer and Hoffman render the structure and composition of the instant invention obvious, including the amended adhesive pattern, which inherently provides a higher and lower adhesion at interface, as set forth above.

Finally, applicants argue that there is no valid reason to combine the teachings of Fischer and Hoffman, because they are directed to different end uses. However, since they are both from the same field of endeavor, i.e., detachable adhesive identification sheet products, the combination of their teachings is proper.

Conclusion

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Victor S Chang
Examiner
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12/4/2006